

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. FIGUEROA

Appeal No. 97-0088
Application No. 29/015,807¹

ON BRIEF

Before LYDDANE, HAIRSTON, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the single design claim pending in this design application.

We REVERSE.

¹ Application for patent filed December 28, 1993.

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BACKGROUND

The appellant's invention relates to a design for a tool blade. The claim on appeal is:

The ornamental design for a tool blade for installing tiles as shown and described.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Gallagher 3,155,997
Nov. 10, 1964

Hyde Tools Catalog (Hyde), page 4, #C2E-4, Wall
Scraper (1963)

The design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Hyde in view of Gallagher.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejection, we make reference to the examiner's answer (Paper No. 19, mailed July 9, 1996) for the examiner's complete reasoning in support of

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the rejection, and to the appellant's brief (Paper No. 18, filed April 9, 1996) for the appellant's arguments thereagainst.

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OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's drawings, specification and claim and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we have determined that the examiner's rejection of the appellant's design claim under 35 U.S.C. § 103 as being unpatentable over Hyde in view of Gallagher cannot be sustained.

At the outset, we keep in mind that, in a rejection of a design claim under 35 U.S.C. § 103, there is a requirement that there must be a single basic reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. See In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993) and In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

The examiner relies upon the appearance of the wall scraper of Hyde as the basic design reference, i.e., as a "Rosen" reference (answer, pp. 2 & 3). The appellant concedes (brief, p. 3) that the wall scraper of Hyde closely simulates the shape of

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their blade in general appearance. We agree that Hyde is a basic design reference.

At this point, we note that once such a basic design reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. See In re Harvey, 12 F.3d at 1063, 29 USPQ2d at 1208. These secondary references may only be used to modify the basic design reference if they are so related to the basic design reference that the appearance of certain ornamental features in one would have suggested the application of those features to the other. See In re Borden, 90 F.3d 1570, 1574, 39 USPQ2d 1524, 1526 (Fed. Cir. 1996). However, such modifications cannot destroy fundamental characteristics of the basic design reference. See In re Rosen, supra. Thus, the focus in a design patent obviousness inquiry should be on visual appearances rather than design concepts. See In re Harvey, 12 F.3d at 1064, 29 USPQ2d at 1208.

The difficulty we have with the examiner's rejection is that the examiner concludes that it would have been obvious to modify the wall scraper of Hyde to accommodate a central square

projection from the blade as taught by Gallagher (answer, p. 3). We do not agree. First, we see no suggestion of why one skilled in the art would have modified Hyde's wall scraper in the manner set forth by the examiner. Second, even if Hyde's wall scraper were modified by the teachings of Gallagher, it would not have resulted in the overall design claimed by the appellant. We share the appellant's view (brief, p. 4) that the applied prior art designs do not teach and would not have been suggestive of a planar blade having a central tooth extending forwardly of a linearly straight working edge. In that regard, it is our opinion that the visual impression of how appellant's linearly straight working edge flows inwardly from each side to the forwardly extending central tooth (as shown in the upper portion of Figures 1, 5 and 6) is significantly different from the visual impressions of Gallagher's tool (shoulders 5 extend from each side at a 45° angle to the forwardly extending central tooth 4, 6 as shown in Figures 1 and 3) and the wall scraper of Hyde (linearly straight working edge flows from side to side without interruption). Finally, we agree with the appellant (brief, p. 4) that, at best, the applied prior art would

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have suggested only that the rectilinearly straight working edge of Hyde be modified to have shoulders extending from each side at a 45° angle to converge on a forwardly extending central tooth as taught by Gallagher.

CONCLUSION

To summarize, the decision of the examiner to reject the claim under 35 U.S.C. § 103 is reversed.

REVERSED

WILLIAM E. LYDDANE)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APJ NASE

APJ LYDDANE

APJ HAIRSTON

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 25 Nov 98

FINAL TYPED: